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HARNESS, DICKEY & PIERCE P.L.C.  
7700 BONHOMME  
SUITE 400  
ST. LOUIS, MO 63102

EXAMINER

THOMPSON, MICHAEL M

ART UNIT

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3763

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**  
**NOV 05 2002**  
**GROUP 8700**

Application Number: 09/200,055  
Filing Date: November 25, 1998  
Appellant(s): GARIBALDI ET AL.

\_\_\_\_\_  
Elizabeth D. Odell  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed August 26, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

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**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 3, 9, 15-16, 19, 26, 30, 34-37, and 41-42 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

4,244,362	ANDERSON	1-1981
5,931,818	WERP et al.	8-1999

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3, 9, 15-16, 19, 26, 30, 34-37, and 41-42 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson, U.S. 4,244,362. This rejection is set forth in prior Office Action, Paper No. 13.

Claims 3, 9, 15, 19, 26, and 30 are now rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Werp et al., U.S. Patent No. 5,931,818 (hereinafter Werp). Claims 16, 34-37, and 41-42 have been withdrawn from the instant rejection. This rejection is set forth in prior Office Action, Paper No. 13.

**(11) Response to Argument****Anderson Rejections:**

The primary issues regarding the patentability of claims 3, 9, 15-16, 19, 26, 30, 34-37, and 41-42 are two-fold. The first primary issue is whether or not the Anderson patent either inherently or obviously teaches a device *comprising* "a flexible magnetic material," which constitutes the magnet for claims 3, 9, 15, 19, 26, and 30. The second primary issue is whether or not the Anderson patent either inherently or obviously teaches a device which *comprises* "a plurality of magnets on the distal end section of the guide wire in a spaced apart relation." The

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third primary issue is whether or not the Werp patent is properly rejected under obviousness-type double patenting.

In addressing the first primary issue of whether or not the Anderson patent either inherently or obviously teaches a device *comprising* a “flexible magnetic material,” which constitutes the magnet, the Examiner believes that a proper interpretation of inherency at least partly lies within the inherent features of basic physical properties of materials. As stated by Applicant, the Examiner had taken the position that the magnetic material taught by Anderson is inherently flexible with regard to other materials. The Examiner still supports this assertion and will clarify the position of Examiner’s rejection. A study of basic physical properties of materials clearly teaches that each and every material or composition of materials will contain a certain Modulus of Elasticity which is a measure of flexibility. Arguably, a material with any degree of Elasticity contains some measurable degree of flexibility. It is this argument alone that one might argue that the magnetic material taught by Anderson is inherently flexible with regard to other materials. However, in order to construe these statements in a proper light for Appeal, as Appellant understands, one must turn to Applicant’s specification for a reasonable determination of what Applicant considers to be a flexible magnetic material. In Applicant’s own specification, Applicant cites neodymium-iron-boron ~~or samarium cobalt~~ as two suitable materials that Applicant considers to be flexible magnetic materials.

For purposes of clarification of the position pending in the rejection of the claims under 35 U.S.C. 102, the Examiner will focus on the samarium cobalt material to provide an example of what Applicant considers to be a flexible magnetic material. It should be noted that Applicant has not actually presented any claims reciting the materials Applicant considers to be flexible.

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This is merely intended to provide an outline for determining what materials constitute a flexible material in light of Applicant's disclosure. Furthermore, while anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure in *haec verba*. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Finally, it is further the Examiner's position that during examination claim limitations are to be given their broadest reasonable reading. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed Cir. 1989).

Therefore, one might consider a reasonable interpretation of the materials taught by the prior art and in light of the materials suggested by Applicant to provide a reference of the properties considered by Applicant to be novel or otherwise. It is clear that Anderson teaches the use of cobalt as a suitable material for construction of the magnet or magnets. (column 7, lines 31-39) Therefore, one must consider the inherent physical properties of the materials taught by the prior art in light of the materials taught by Applicant. More specifically, one must consider their relative Modulus of Elasticity and determine a reasonable interpretation of that Elasticity.

As Applicant understands, samarium cobalt, for example, inherently has a Modulus of Elasticity of about 23 times ten to the sixth power PSI (pounds per square inch) considered to be 23 million PSI or about 159 GPa (GigaPascals) which are two standard units of measurement of pressure. These measurements are an inherent property that provides a measure of flexibility. This was therefore the basis of determining the relative criterion for what Applicant considers to be a flexible magnetic material.

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Turning back to the Anderson patent, Anderson teaches the use of cobalt as the preferred material which constitutes the magnet. Cobalt inherently has a Modulus of Elasticity of about 3 times ten to the seventh power PSI which is considered to be 30 million PSI or about 207 GPa. It is therefore the Examiner's position that the difference in the Modulus of Elasticity is small when construed in the context of the actual difference in flexibility provided between these two materials. To properly construe these differences in the context of Applicant's suggested materials one must consider examples of different materials having different inherent elasticity. For example, when one thinks of the common interpretation of "flexible" one might think of a rubber material. The inherent Modulus of Elasticity of rubber is about 102 PSI or about 0.0007 GPa. However, if one considers what Applicant considers to be "flexible" one might think of, for example cast iron or platinum. The inherent Modulus of Elasticity of cast iron and platinum are about 12-24 million PSI (83-170 GPa) or about 21 million PSI (145 GPa). The closest example to Applicant's material is the example of Platinum. Platinum in comparison to rubber shows a difference of slightly less than 21 million PSI. However, when one considers the flexibility of platinum as compared to samarium cobalt (as suggested by Applicant) the difference is merely 2 million PSI. This construction gives a proper framework for the Examiner to determine what range Applicant considers to be a flexible magnetic material by possessing the knowledge of the inherent properties of materials and their inherent flexibilities. In addressing the rejection under 35 U.S.C. 103 it was the Examiner's position that there might be a second reasonable interpretation of the claimed "flexible magnetic material." If the claims are in fact construed in their broadest terms, the second reasonable interpretation might provide for a grouping of magnetic material that is collectively flexible. Such is consistent with the teachings

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of Anderson. It should be noted that the Examiner specifically addressed this issue in his response to arguments to provide Applicant with the second possible interpretation as recited above.

In conclusion, when one construes what Applicant considers to be a "flexible magnetic material," it is clear that in the least Anderson inherently teaches a similar Modulus of Elasticity. Anderson thus teaches the Modulus of Elasticity as a suitable property for a magnetic material that is sufficiently flexible to meet the claim limitations as recited by Applicant in light of Applicant's own specification and disclosure.

In addressing the second primary issue of whether or not the Anderson patent either inherently or obviously teaches a device that *comprises* "a plurality of magnets on the distal end section of the guide wire in a spaced apart relation," it is the Examiner's position that Anderson does in fact teach a plurality of magnets in a spaced apart relationship. The plurality of magnets (60 as shown in Anderson) is in a spaced apart relationship as clearly shown in Figure 11. It is the Examiner's position that Applicant has failed to recite any limitations other than the magnets have a spaced apart relationship. A proper reading of the prior art clearly provides a teaching of Anderson wherein the magnets will have a spaced apart relationship with one another. For purposes of 35 U.S.C. 102 it is the Examiner's position that, in the least, a *prima facie* case has been made with respect to the limitations in light of the law of anticipation as stated above.

In addressing the third primary issue of obviousness-type double patenting with respect to claims 3, 9, 15, 19, 26, and 30 of the instant application the Examiner asserts that Appellant's arguments are factually incorrect. To determine whether any claim in the application defines an invention that is merely an obvious variation of an invention claimed in a patent, the law is clear



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that any analysis employed in the obvious-type double patenting rejection parallels the guidelines for an analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). The M.P.E.P. teaches at §1242 that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, whether in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.**

Thus, in order to sustain a rejection under judicially created doctrine of obviousness-type double patenting, the prior art reference must teach or suggest all of the claim limitations of the claims rejected by the Office Action. It is the Examiners position that the instant obviousness-type double patenting rejection meets each of the above criteria. In fact, Werp both teaches and further suggests the use of a flexible magnetic material. As discussed above, Applicant teaches one of the suitable flexible magnetic materials as being neodymium-iron-boron. The claims of Werp recite a magnet wherein the magnet is taught to be made of neodymium-iron-boron. Appellant's own application recites that this magnetic material is a suitable material for the construction of a flexible magnetic magnet. It is the Examiner's position that a proper reading of the magnet of Werp is clearly flexible and therefore constitutes the basis for rejection.

Therefore, in light of the arguments set forth above the Examiner will specifically address several random assertions made by Appellant that have yet to be traversed. On page 7, lines 2-3, Appellant asserts that Anderson teaches away from magnetically attracting the distal portion of the stylet so as to cause lateral movement of the distal portion which is factually incorrect. In fact, Anderson very clearly shows the use of an external magnet to attract the distal portion of the

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stylet to cause a lateral movement from the original axis to steer the stylet/guidewire into a specific body passage. It is submitted that Applicant's discussion of the stylet having a coiled spring that is non-magnetic is not germane in that the Examiner is not relying upon the spring to constitute the magnetic means. It should also be noted that the Examiner did not necessarily rely upon coil (55) of Anderson as a teaching for magnetized materials.

On page 7 lines 4-12, Appellant describes the characteristics of a flexible stainless steel braid, however, fails to claim such a braid. It is submitted that the braid mentioned herein is not germane to the issues at hand. Applicant claims the distal portion of the guidewire can be moved in any direction. It is the Examiner's position that Anderson teaches similarly. Lastly, Applicant asserts that the distal end of the guidewire is "so highly flexible" that it enables capture and recovery of objects. Given arguments supra as to a reasonable interpretation of the "flexibility" of Applicant's material, the Examiner asserts that Anderson teaches the same flexibility.

Page 7, lines 25-29, Applicant asserts that the limitations of claim 26 have not been met. This is factually incorrect. An examination of Figure 5 clearly shows the guidewire/stylet in the lumen at the distal end of the medical device. In the least, it is inherent that the user, prior to insertion, will have placed the stylet into the medical device until the medical device has been placed in the body. Then the user will have extended the device through the distal end. Similarly, this argument is suitable for claim 27 on discussed on pages 10 and 11, to include Applicant's discussion of claims 35-37 as asserted on page 8, paragraph 3.

In summary, it is the Examiner's position that, in the least, the Examiner has rejected Applicant's claims with a suitably flexible material when construed in light of Applicant's specification and disclosure. The Examiner has further provided arguments directed to a state or

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point of usage wherein the magnets clearly *comprise* [emphasis added] a spaced apart relationship. Lastly, the Examiner has provided a proper basis for the rejections under obviousness-type double patenting. For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Michael M. Thompson


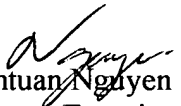

Examiner

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MMT   
November 4, 2002

Conferees:

Brian Casler  
Supervisory Patent Examiner

  
**BRIAN L. CASLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**  
Anhtuan T. Nguyen  
Primary Examiner  
**ANHTUAN T. NGUYEN**  
**PRIMARY EXAMINER**

**BRYAN K. WHEELLOCK**  
**DOEPKEN KEEVICAN & WEISS**  
**15TH FLOOR, ONE METROPOLITAN SQUARE**  
**211 NORTH BROADWAY**  
**ST. LOUIS, MO 63102**